

REMARKS

Applicants' Representatives would like to thank Examiner Thomas for taking the opportunity to speak with us on October 2, 2007 and October 3, 2007. As discussed, because SEQ ID NO:4518 was found to be free of the prior art on First Action on the Merits, Applicants' Representatives requested that an additional sequence be searched in response to the First Action, since there would be no additional search burden in view of the search results regarding SEQ ID NO:4518. It was pointed out to Applicants' Representatives that filing an RCE was necessary to have the new sequence searched. Since Applicants have the opportunity to file a response to a First Action on the Merits, as a matter of right, Applicants submit this amendment.

The new and amended claims meet with the restriction because they are drawn to isolated polynucleotides and include the elected species (i.e., SEQ ID NO:4518). Therefore, Applicants submit that the subject matter contained therein should not be considered independent and distinct from the invention previously claimed.

Applicants respectfully requests entry of amendments to claims 29-33, 37, 39-41, 52, 54, and 55, and the addition of new claims 56-76. Please cancel claims 28, 34-36, and 38, and withdraw claims 1-27 and 43-51, without prejudice or disclaimer. Support for the amendments can be found throughout the specification, including paragraph [0100], Tables 3A, 3B, 5, and 6, the Sequence Listing, and the originally filed claims and, therefore, do not add new matter.

Applicants submit that pending claims 29-33, 37, 39-42, and 52-76 are in condition for allowance, or are in better condition for presentation on appeal, and respectfully request that the claims as amended be entered.

Specification

The Office Action states that Tables 5 and 6 are not in the specification or on the discs as filed. Applicants have reviewed the two copies of the discs retained with the file, where the information was found intact. Nevertheless, Applicants have provide a copy of Tables 5 and 6, herewith, as Appendix 1.

Rejection Under 35 U.S.C. §112, Second Paragraph

Claim 36 stands rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. As claim 36 has been canceled, the rejection as applied to this claim is rendered moot.

For these reasons, Applicants respectfully request that the rejection be withdrawn.

Rejections Under 35 U.S.C. §102

Claim 28 stands rejected under 35 U.S.C. §102(b), as allegedly being anticipated by Adams et al.

Applicants traverse the rejection as it might apply to the new and amended claims, including claims dependent therefrom, for the reasons given below.

As claim 28 has been canceled, the rejection as applied to this claim is rendered moot. For these reasons, Applicants respectfully request that the rejection be withdrawn.

Claims 32-35 and 37-40 stand rejected under 35 U.S.C. §102(b), as allegedly being anticipated by New England Biolabs Catalog, Random Primer 24 (NEB Product #1256).

Applicants traverse the rejection as it might apply to the new and amended claims, including claims dependent therefrom, for the reasons given below.

As claims 34, 35, and 38 have been canceled, the rejection as applied to these claims is rendered moot.

The Office Action states that “[n]o prior art was found that teaches” (a) an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518 or (b) comprises SEQ ID NO:4518 or (c) wherein the polynucleotide further comprises a detectable label at a position corresponding to position 300 of SEQ ID NO:4518.

Claims 32 and 37 have been amended to recite an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518, thus, the cited art does identically disclose all of the elements of the claims as amended. Regarding claims 52, 54, and 55, the oligonucleotide constituent in the kit also recites the same element, therefore, the

cited art does not anticipate these claims as amended. Further, regarding new claims 56 and 68 (including claims dependent therefrom), these new claims recite “comprising at least SEQ ID NO:4518,” thus, they too are not anticipated by the cited reference. Regarding new claim 69 (including claims dependent therefrom), as the sequences recited in the claim are not identically disclosed in the cited reference, the cited reference does not anticipate the claim.

As stated in Hybritech Inc. v. Monoclonal Antibody, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986), “It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention.”

Therefore, because the instant claims recite the elements as recited for Item (a) or (b), *supra*, the New England Biolabs reference does not anticipate the invention as claimed.

Failure of the prior art to meet every element of the claimed invention does not meet the standard under §102. For these reasons, Applicants respectfully request that the rejection, including as it may be applied to the new and amended claims, be withdrawn.

Claims 32, 35, 37, 39, 52, 54, and 55 stand rejected under 35 U.S.C. §102(b), as allegedly being anticipated by Fodor et al.

Applicants traverse the rejection as it might apply to the new and amended claims, including claims dependent therefrom, for the reasons given below.

As claim 35 has been canceled, the rejection as applied to this claim is rendered moot.

The Office Action states that “[n]o prior art was found that teaches” (a) an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518 or (b) comprises SEQ ID NO:4518 or (c) wherein the polynucleotide further comprises a detectable label at a position corresponding to position 300 of SEQ ID NO:4518.

Claims 32 and 37 have been amended to recite an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518, thus, the cited art does not identically disclose all of the elements of the claims as amended. Regarding claims 52, 54, and 55, because the oligonucleotide constituent in the group also recites the same element (i.e., Item (a)), again, the cited art does not anticipate these claims as amended. Further, regarding new claims 56 and 68 (including claims dependent therefrom), these new claims recite

“comprising at least SEQ ID NO:4518,” thus, they too are not anticipated by the cited reference. Regarding new claim 69 (including claims dependent therefrom), as the sequences recited in the claim are not identically disclosed in the cited reference, the cited reference does not anticipate the claim.

As stated Hybritech Inc. v. Monoclonal Antibody, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986), “It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention.”

Therefore, because the instant claims recite the elements as recited for Item (a) or (b), *supra*, the Fodor et al. reference does not anticipate the invention as claimed.

Failure of the prior art to meet every element of the claimed invention does not meet the standard under §102. For these reasons, Applicants respectfully request that the rejection, including as it may be applied to the new and amended claims, be withdrawn.

Claim 28 stands rejected under 35 U.S.C. §102(e), as allegedly being anticipated by Wang et al.

Applicants traverse the rejection as it might apply to the new and amended claims, including claims dependent therefrom, for the reasons given below.

As claim 28 has been canceled, the rejection as applied to this claim is rendered moot.

The Office Action states that “[n]o prior art was found that teaches” (a) an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518 or (b) comprises SEQ ID NO:4518 or (c) wherein the polynucleotide further comprises a detectable label at a position corresponding to position 300 of SEQ ID NO:4518.

Claim 41 has been amended to recite dependency from claim 29 (including that claim 42 is dependent from claim 41), and as claim 29 recites an isolated polynucleotide, wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518, the cited art does not identically disclose all of the elements of the claims as amended. Further, regarding new claims 56 and 68 (including claims dependent therefrom), these new claims recite “comprising at least SEQ ID NO:4518,” thus, they too are not anticipated by the cited reference. Regarding new

claim 69 (including claims dependent therefrom), as the sequences recited in the claim are not identically disclosed in the cited reference, the cited reference does not anticipate the claim.

As stated in Hybritech Inc. v. Monoclonal Antibody, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986), “It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention.”

Therefore, because the instant claims recite the elements as recited for Item (a) or (b), *supra*, the Wang et al. reference does not anticipate the invention as claimed.

Failure of the prior art to meet every element of the claimed invention does not meet the standard under §102. For these reasons, Applicants respectfully request that the rejection, including as it may be applied to the new and amended claims, be withdrawn.

Claims 32 and 34 stand rejected under 35 U.S.C. §102(e), as allegedly being anticipated by Wang et al.

Applicants traverse the rejection as it might apply to the new and amended claims, including claims dependent therefrom, for the reasons given below.

As claim 34 has been canceled, the rejection as applied to this claim is rendered moot.

The Office Action states that “[n]o prior art was found that teaches” (a) an isolated polynucleotide wherein the polynucleotide comprises 100 contiguous nucleotides of SEQ ID NO:4518 or (b) comprises SEQ ID NO:4518 or (c) wherein the polynucleotide further comprises a detectable label at a position corresponding to position 300 of SEQ ID NO:4518.

Regarding claim 32, the claim has been amended to recite that a polynucleotide “is complementary to at least 100 contiguous nucleotide of SEQ ID NO:4518.” Since 100 contiguous nucleotides of SEQ ID NO:4518 are not anticipated by the cited art, neither is the polynucleotide as recited in claim 32. Further, regarding new claims 56 and 68 (including claims dependent therefrom), these new claims recite “comprising at least SEQ ID NO:4518,” thus, they too are not anticipated by the cited reference. Regarding new claim 69 (including claims dependent therefrom), as the sequences recited in the claim are not identically disclosed in the cited reference, the cited reference does not anticipate the claim.

As stated in Hybritech Inc. v. Monoclonal Antibody, Inc., 231 U.S.P.Q. 81 (Fed. Cir. 1986), "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention."

Therefore, because the instant claims recite the elements as recited for Item (a) or (b), *supra*, the Wang et al. reference does not anticipate the invention as claimed.

Failure of the prior art to meet every element of the claimed invention does not meet the standard under §102. For these reasons, Applicants respectfully request that the rejection, including as it may be applied to the new and amended claims, be withdrawn.

In re Application of:
DeNice et al.
Application No.: 10/750,622
Filing Date: December 31, 2003
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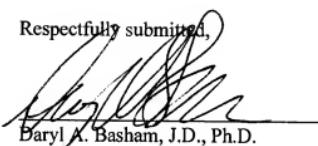
PATENT
Attorney Docket No. MMI1150

Conclusion

Applicants submit that pending claims 29-33, 37, 39-42, and 52-76 are in condition for allowance, or are in better condition for appeal. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this submission.

Please charge Deposit Account No. 07-1896 in the amount of \$1050.00 to cover a Three Month Extension of Time fee. The Commissioner is hereby authorized to charge any additional fees required by this submission, or make any credits or overpayments, to Deposit Account No. 07-1896 referencing the above-identified attorney docket number.

Respectfully submitted,



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